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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,160	12/28/2000	Anthony B. Eoga	PA00-1010-Y	8687

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EXAMINER	
ANTHONY, JOSEPH DAVID	
ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,160	EOGA, ANTHONY B.	
	Examiner	Art Unit	
	Joseph D. Anthony	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6,8-26 and 30-33* is/are pending in the application.

4a) Of the above claim(s) *15-26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-6, 8-14, and 30-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

FINAL REJECTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Dependent claim 8 is deemed to contain new matter in regards to the limitation: "wherein the polyethylene is of a molecular weight in the range of about 350,000 to 8,000,000". A detailed examination of the application shows absolutely no support for applicant's said polyethylene oxide molecular weight range of "about 350,000". The last line on page 8 through the first line on page 9 of the specification discloses polyethylene oxide of a molecular weight in the range of about 100,000 to 8,000,000. The same polyethylene oxide of a molecular weight in the range of about 100,000 to 8,000,000 is set forth on page 13, lines 13-17 of applicant's specification. If applicant desired to limit the polyethylene oxide molecular weight to "about 350,000 to 8,000,000", applicant will need to file another application as a CIP application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-6, 8, and 11-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roth et al. U.S. patent Number 5,418,006.

Roth et al discloses a method for coating a substrate surface with an aqueous composition comprising a film-forming substance, a water repelling substance and optional adjuvants such as surfactant, see column 2, line 23 to column 3, line 68. The coating can be removed with water and can be used to protect the coated surface from graffiti, see the abstract, column 4, line 28 to column 5, line 66, column 5, line 67 to column 6, line 6. Applicant's claims are deemed to be anticipated over Examples 4-5 wherein carboxymethylcellulose is used as the film-forming substance in the surfactant containing aqueous coating composition used to coat the substrate. In the alternative, Roth et al may differ from applicant's claimed invention in that it is unclear what the

molecular weight is of the carboxylmethylcellulose used in Examples 4-5. In the case that Examples 4-5 use a carboxymethylcellulose having a molecular weight that is outside of applicant's claimed range of "about 350,000 to 8,000,000" as set forth in claim 8 only,such would be obvious since carboxymethylcellulose agents are notoriously well known in the art to have molecular weights within "about 350,000 to 8,000,000", and such a molecular weight range is deemed to come directly within the broad disclosure of the patent. In any case the Examples 4-5 were given by way of illustration and not by way of limitation.

6. Claims 9-10 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. U.S. patent Number 5,418,006.

Roth has been described above and this rejection builds thereon. Roth differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a coating composition that actually comprises a coloring agent (claim 9), a fragrancing agent (claim 10), or one of applicant's specifically claimed polyethylene oxide species or surfactant species, as set forth in new claims 30-33.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Roth as set forth in column 2, line 23 to column 4, line 65 as motivation to actually make a coating composition that comprises a coloring agent, a fragrancing agent, or one of applicant's specifically claimed polyethylene oxide species or surfactant species since all said components fall directly within said disclosure of the patent. Please note

that Roth's optional metal oxides, such as titanium oxide, see column 4, lines 16-29, are well known pigments.

7. Claims 1, 3-6, and 8-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murayama U.S. Patent Number 5,401,495.

Murayama teaches a three-component system to whiten teeth and a method of its use, see column 2, line 52 to column 7, line 35. Applicant's invention is deemed to be anticipated over Example 4 when the "Polishing and Pigmenting Cream" is applied to the teeth of a person. It must be noted that the "Polishing and Pigmenting Cream" contains in part: carboxymethylcellulose 7MP and components that can be considered to be surfactants. In the alternative, Murayama may differ from applicant's claimed invention in that it is unclear what the molecular weight is of the carboxylmethylcellulose 7MF component used in Example 4. In the case that the carboxylmethylcellulose 7MF used in Example 4 has a molecular weight that is outside of applicant's claimed range of "about 350,000 to 8,000,000" as set forth in claim 8 only, it would be obvious to use another carboxymethylcellulose agent having a molecular weight of "about 350,000 to 8,000,000" since such molecular weight ranges are notoriously well known in the art, and such a molecular weight range is deemed to come directly within the broad disclosure of the patent. In any case the Example 4 was given by way of illustration and not by way of limitation.

8. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murayama U.S. Patent Number 5,401,495.

Murayama has been described above and this rejection builds thereon. Murayama differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a coating composition that actually comprises one of applicant's specifically claimed polyethylene oxide species or surfactant species as set forth in new claims 30-33.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Murayama as motivation to actually make a coating composition that comprises or one of applicant's specifically claimed polyethylene oxide species or surfactant species since all said components fall directly within said disclosure of the patent.

9. Claims 1, 3-6, 9-14 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek U.S. Patent Number 4,861,583.

Sramek teaches aqueous hot curling hair treatment compositions that comprise water soluble polyethylene oxide polymer that have a molecular weight between about 20,000 to about 250,000, see abstract and claim 1. The hair treatment compositions can be washed out of the hair with water at any time. Optional adjuvants are surfactants wetting agents, dyes, perfumes etc., see column 3,lines 30-61. Sramek differs from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to a hair treatment composition that actually comprises a water soluble

polyethylene oxide that has a molecular weight of greater than 250,000. Likewise, applicant's specifically claimed polyethylene oxide species and surfactant species are not directly taught (i.e. by way of an example).

It would have been obvious to one having ordinary skill in the art to actually make and use a hair treatment composition that contained a water-soluble polyethylene oxide polymer having a high molecular weight since Sramek directly discloses and claims the use of polyethylene oxide within a range of between 20,000 and about 250,000. It would also have been obvious to one having ordinary skill in the art to use the broad disclosure of Sramek as motivation to actually make a coating composition that comprises or one of applicant's specifically claimed polyethylene oxide species or surfactant species since all said components fall directly within said disclosure of the patent.

Response to Arguments

10. Applicant's arguments filed 03/04/2005 with the amendment have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth now. The rejection of applicant's claim 8 over Sramek U.S. Patent Number 4,861,583 has been dropped due to applicant's new matter which was added to claim 8, but will be restored if the new matter is deleted from the claim.

Applicant's arguments that the originally filed specification has support for the newly added weight range of "wherein the polyethylene is of a molecular weight in the range of about 350,000 to 8,000,000" as set forth in dependent claim 8, is totally rejected by the examiner

since the lower limit of "about 350,000" is found nowhere in applicant's specification. Applicant's contention that it is known in the art that high molecular weight polyethylene oxides have a lower molecular weight of "about 350,000 to 500,000" is also totally rejected by the examiner since applicant has set forth no objective evidence for said contention. Applicant's newly submitted "Exhibit A" has no mention of the phrase "high molecular weight" in regards to polyethylene oxide. Furthermore, the only molecular weight range listed by Exhibit A is 500,000 to 10,000,000.

In the REMARKS section of applicant's response applicant asserts that the applied Roth et al patent teaches away from applicant's claimed process since Roth et al teaches a pre-requisite impregnation step of the surface prior to applying the film-forming coating, and a post-impregnation step of the surface after applying the film-forming coating. The examiner holds that both of these steps of Roth et al do not in any way make for a patentable distinction between applicant's claimed invention and that of Roth et al. In the first place, applicant's claims are drawn to a composition, not to a process of coating a substrate. As such, Roth et al's disclosed additional taught process steps which are not needed when applicant applies his composition to a surface are deemed to be irrelevant to the patentability of the pending composition claims. Furthermore, applicant's contention that Roth et al' post-impregnation step renders the surface water-repellent and thus teaches away from applicant's claimed invention is not true. Applicant's attention is drawn to Roth et al's column 6, line 67 to column 7, line 11, as well as the examples, wherein Roth et al make it very clear that a post-impregnated coated substrate can have its coatings removed with a water solvent.

Applicant's arguments that the Muryama's three-component polishing and pigment cream is some how distinct from applicant's claimed composition because it is no removed from the teeth, is clearly false since said cream is removed from the patients teeth once the polishing process is completed. In any case, applicant is claiming a composition not a method of using the composition.

In regards to the applied Sramek patent, applicant argues that Sramek does not have a teaching to removing the coating at room temperature. This position of applicant's is false. Sramek makes it super clear throughout the patent that the hair coating compositions are removed from the hair with water as a solvent, see column 3, lines 56-57. In any case, applicant is claiming a composition not a method of using the composition.

Conclusion

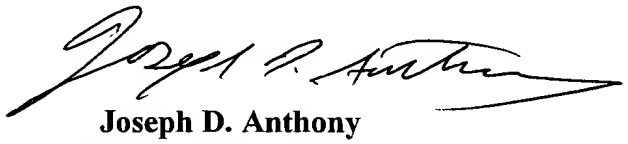
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

5/30/05